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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,194	11/18/2003	John Thomas Carter II	17570	4130

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EXAMINER	
HUYNH, CONG LAC T	
ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/716,194	CARTER, JOHN THOMAS	
	Examiner	Art Unit	
	Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/1/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: the application filed on 11/18/03, and the IDSs filed on 10/1/07.

2. Claims 1-20 are pending in the case. Claims 1, 10, and 20 are independent claims.

Claim Objections

3. Claims 2 and 20 are objected to because of the following informalities: the phrases, "The system of *claim*" (claim 2, line 1) and "replacing the include tag with the default display *of step if*" (claim 20, line 21) include typographical errors. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim is directed to a system for selecting the appearance of a display on a viewer. However, none of the system elements is a physical part of a device but instead the system elements are merely software per se. The claimed system does not constitute part of a device or a combination of devices to be a machine within the meaning of 101. Claim 1, therefore, fails to fall within a statutory category of invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agarwalla et al. (US 2004/0015538, 1/22/04, filed 7/18/02).

Regarding independent claim 20, Agarwalla discloses:

- upon activation of a simple html output command to the server, finding at least one include tag for the server output ([0036], [0042])
- executing the at least one include tag generating a custom or default display determined by the absence or presence of a unique identifier ([0036], [0042]: executing the at least one include tag generating a custom display determined by the presence of a cookie)

- caching the customized web page with the replaced include tag ([0042], [0036]-[0037])

Agarwalla does not displaying the selected html output on the viewer. However, it would have been obvious to an ordinary skill at the time of the invention was made to modify Agarwalla to include the displaying step on the viewer, which is a computer display, since once the web page is cached at a server, it was well known that the cached web page can be retrieved and displayed on a monitor, which is a viewer, at client or server. Displaying such a cached web page would provide a user the ability of viewing different looks of a web page whenever it is customized.

Claim 10 is a machine of method claim 20, and is rejected under the same rationale.

Regarding claims 11 and 14, which are dependent on claim 10, it is clear that the method of claim 20 is applied on a computer, and so the machine to perform the method is a computer, and since the method is involved in web pages, the viewer should comprises a web browser.

Regarding claims 12-13, which are dependent on claim 10, since it was well known that Internet can be accessed from a television and a picture cell phone, the machine for performing method claim 20 can be a television and a picture telephone.

Regarding claim 15, which is dependent on claim 10, Agarwalla discloses:

- upon activation of a simple html output command to the server, finding at least one include tag for the server output ([0036], [0042])
- executing the at least one include tag generating a custom or default display determined by the absence or presence of a unique identifier ([0036], [0042]: executing the at least one include tag generating a custom display determined by the presence of a cookie)
- caching the customized web page with the replaced include tag ([0042], [0036]-[0037])

Agarwalla does not that the output command activated at the server is a perl html output command and displaying the selected html output on the viewer. However, it would have been obvious to an ordinary skill at the time of the invention was made to modify Agarwalla to include the displaying step on the viewer, which is a computer display, since once the web page is cached at a server, it was well known that the cached web page can be retrieved and displayed on a monitor, which is a viewer, at client or server. Displaying such a cached web page would provide a user the ability of viewing different looks of a web page whenever it is customized. Also, it would have been obvious to an ordinary skill at the time of the invention was made to modify Agarwalla to include different programming languages such as perl for a perl html output command activated at the server since perl is well known a programming language for scripting at server.

Regarding claim 16, which is dependent on claim 15, it is clear that the machine used in Agarwalla is a computer.

Regarding claim 17, which is dependent on claim 15, since it was well known to use a television for accessing Internet service, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a television as the machine to access Internet.

Regarding claim 18, which is dependent on claim 15, Agarwalla does not disclose a machine comprises a picture telephone. However, it was well known to use a picture telephone, or cell phone, to access Internet. Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have a picture telephone as a machine in Agarwalla.

Regarding claim 19, which is dependent on claim 15, it is clear that the viewer in Agarwalla is a web browser.

Regarding independent claim 1, Agarwalla discloses:

- executing include tags generating a set of variables that indicates the desired display appearance ([0036], [0042])
- find an include tag and replace the include tag with new values that indicate the desired display appearance for variables ([0036], [0042]:) determined by either:

- a unique identifier set in the machine by the server, whereby the unique identifier identifies the desired display appearance ([0030]-[0032]), or in the event there is no unique identifier set by the server, by
- the default set of variables indicating the desired display appearance above

Agarwalla does not disclose that the viewer displays the desired appearance. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Agarwalla to include the display of the desired appearance since it was well known that the web page, particularly a personalized web page, when cached and associated with a cookie, would be served to a user via rendering and displaying at the user's computer. Displaying a personalized web page on the user's computer would effectively render a web page in the requested form to the user.

Regarding claims 2 and 6, as seen in Agarwalla, it is clear that the viewer is a web browser and the server is a web server (figure 2).

Regarding claims 3-5, though Agarwalla does not explicitly disclose that the viewer comprises a television and a picture telephone where the picture telephone comprises a wireless telephone, it was well known that television and a picture cell phone provide Internet services to user. Therefore, it would have been obvious to one of ordinary skill

in the art at the time of the invention was made to include television and wireless cell phone as viewers for displaying the requested web pages from users.

Regarding claims 7-9, though Agarwalla does not explicitly disclose that the server comprises a digital television converted box where the converted box receives digital cable television content and digital satellite television content, it was well known that the digital television converted box includes these functions for receiving web content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include a server as a digital television converted box for receiving web content for user's request.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art of record is listed on PTO 892.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cong-Lac Huynh/
Primary Examiner, Art Unit 2178
05/08/08